

## **REMARKS**

Claims 58-70, 74-76 and 78-81 are pending. Claims 58-70, 74-76 and 78-81 were rejected in the Office Action dated March 18, 2009. Reconsideration of all rejected claims is requested in light of the arguments and amendments presented here.

### **Double Patenting Rejection**

Claims 58-71, 74-76 and 78-81 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over new claims 1-17 of copending U.S. Patent Application No. 11/932,752 [IGT1P369D1C1US] filed October 31, 2007 to Martinek et al. ("Martinek"). Claims 58-71, 74-76, and 78-81 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of US Patent No. 7,470,182. As the present claims are rejected on other grounds and may be amended or cancelled prior to issuance, a terminal disclaimer is believed to be premature at this time.

### **Claim Rejections Under 35 U.S.C. §103**

Claims 58-70, 74-76 and 78-80 were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,805,634 to Wells et al. ("Wells"). Claim 58 recites, "an operating system that runs on the computerized game controller, the operating system comprising an operating system kernel and a system handler application," and "the system handler application comprising an Application Program Interface comprising functions callable from the gaming program shared objects, the Application Program Interface comprising a plurality of gaming functions callable by and used by the plurality of the gaming program shared objects, the plurality of functions stored in the computerized game controller." The Office action appeared to consider the operating system, including all the above features to be inherent in Wells. However, while some sort of operating system might be inherent (no position is taken with respect to this possibility), an operating system with all of the above features is not inherent because an operating system does not necessarily include a system handler application comprising an API comprising functions callable from gaming program shared objects. It is not clear if the rejection is based on considering these features inherent, or considering it obvious to modify Wells to add an

operating system with such features. “It is perhaps viewed by the examiner that the operating system is inherent in Wells, but in any case is most surely obvious to one of average skill in the art that an operating system software has been placed in the Game Controller Board in order to execute all the functions described by Wells.” Office action, page 6, lines 24-28. To the extent that the rejection is based on inherency, it is requested that the Examiner provide some rationale or evidence. “Examiner must provide rationale or evidence tending to show inherency.” MPEP 2112 IV. It is submitted that all of the functions of Wells are not necessarily carried out by an operating system, and may be carried out by other software (e.g. applications), or hardware, or a combination thereof.

To the extent that the rejection is based on modifying Wells, no rationale is stated for such a modification. For example, Wells discloses, “Memories coupled to a gaming terminal, are reprogrammed by a method and apparatus which includes identification, negotiation, downloading and verification information from an external information source to a gaming terminal.” Abstract (emphasis added). The Office Action provided no rationale for modifying such an arrangement to obtain, “a plurality of gaming functions callable by and used by the plurality of the gaming program shared objects, the plurality of functions stored in the computerized game controller” of claim 58. Because no such rationale was provided, no *prima facie* case of obviousness was stated with respect to claim 58.

Furthermore, it is not clear what features of Wells are cited as corresponding to “load at least one of the plurality of the gaming program shared objects in response to a change in the stored game data variables by at least another one of the plurality of the gaming program shared objects.” Clarification is requested.

Claim 76 is submitted to be allowable for similar reasons to claim 58. In particular, the Office Action states, “It is perhaps viewed by the examiner that the operating system is inherent in Wells, but in any case is most surely obvious to one of average skill in the art that an Operating System software has been placed in the Game Controller Board in order to execute all the functions described,” section 22, bottom page 10 – top page 11. However, as discussed above, all functions are not necessarily performed by an operating system (even if some operating system were considered inherent). And no rationale is provided for modifying Wells.

Furthermore, claim 76 recites, “the plurality of gaming program shared objects can be used to call a set of common functions stored in the computerized game controller.” The Office

Action cited column 5, lines 4-27 and 45-57. However, these features were not identified and corresponding features were not found in the cited portions. The Office Action stated, “the downloaded program functions are placed in the controller board and called by the boards operating software for execution,” page 10, lines 15-16. These features were not found in the cited text and it is unclear what is meant by “the boards operating software.” To the extent that this refers to an operating system which executes “all the functions described by Wells” then it is unclear how the functions are called by gaming program shared objects. Clarification is requested.

All dependent claims depend from either claim 58 or 76 and are therefore submitted to be allowable at least for depending from an allowable base claim. Furthermore, various dependent claims recite features which provide additional grounds for allowance.

Claim 81 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wells in view of U.S. Patent No. 6,315,666 to Mastera et al. ("Mastera"). However, Mastera does not appear to cure the deficiencies in the rejection as discussed above. Therefore, claim 81 is submitted to be allowable at least for depending from an allowable base claim.

### **New Claims**

Claims 82 and 83 are added and are supported throughout the specification, for example at page 16, lines 8-10. Claims 82 and 83 are submitted to further distinguish over the prior art, although it is unclear what features of Wells are considered as gaming program shared objects and thus unclear what features they might have.

### **Information Disclosure Statement**

References submitted in a Supplemental Information Disclosure Statement dated January 3, 2007 remain unacknowledged. It is respectfully requested that this Supplemental Information Disclosure Statement be considered and the PTO Form 1449 be initialed and returned with the next Action.

A Supplemental Information Disclosure Statement is being filed herewith. It is respectfully requested that this Supplemental Information Disclosure Statement be considered and the PTO Form 1449 be initialed and returned with the next Action.

## **CONCLUSION**

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner has any further matters that need to be resolved, a telephone call to the undersigned at 510-663-1100 would be appreciated.

Respectfully submitted,  
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